

## REMARKS

In the application claims 1-11 and 14-19 remain pending. Claims 12 and 13 have been canceled without prejudice. Certain of the claims have been amended to clarify what the Applicant regards as their invention. Support for the amendments may be found in the specification and figures as originally filed. No new matter has been added.

In the Office Action, the filed Declaration was deemed defective for failing to identify the city and either state or foreign country of residence of each inventor. In response, the Applicant has attached a copy of the Application Data Sheet that was filed with the subject application for patent. The attached copy of the Application Data Sheet was downloaded from the USPTO public PAIR access site, i.e., the Applicant has verified that the Application Data Sheet that was filed with the subject application was, in fact, received by the USPTO. Since the Office Action is correct in noting that the residence information may be provided on either an Application Data Sheet or supplemental oath or declaration and since the residence information may be found on the Application Data Sheet as originally filed, the objection to the Declaration should be withdrawn.

In the Office Action, pending claims 1-19 were rejected under 35 U.S.C. § 103 as being rendered obvious by Pariente (WO 9409570) in combination with one or more of Renner (5679945), Ishikawa (5315392), and/or Krisbergh (5138649). In response, it is respectfully submitted that a *prima facie* case of obviousness under 35 U.S.C. § 103 requires that the combination of prior art references disclose the each and every element set forth in the claims considering each and every word. In addition, when assessing the patentability of a claimed invention, it is impermissible to break an invention into its component parts and then find a reference containing one part, another reference containing another part, etc., while using the specification of the Applicant as a template to combine these parts for the purpose of deprecating that claimed invention. Thus, to assure that such “hindsight

reasoning” is not used, a rejection under 35 U.S.C. § 103 also requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the manner claimed.

Considering now the rejection of claims 1-10 based upon the combination of Pariente and Renner, it is respectfully submitted that Renner cannot be said to suggest modifying the system of Pariente to arrive at the invention claimed. In particular, Renner describes a system for limiting access to physical areas. For example, at Col. 11, lines 15-35, Renner describes that a smart card inserted into an intelligent card reader (ICR) may be utilized to control parking garage gates or other types of entry-inhibiting devices such as safes or file cabinets. In addition, Renner describes that the ICR can be programmed to make access to the physical areas contingent on other parameters such as time of day or day or week or that the ICR can control access to the physical area by limiting the number of times [one may access the physical area] or having a preprogrammed expiration data [beyond which one cannot access the physical area]. While Renner describes various ways of using a smart card and programmed ICR to control access to physical areas, **nowhere does Renner disclose, describe, teach, or suggest, either expressly or inherently, that any data on the Renner smart card is limited to being read only a predetermined number of times by the ICR.** Rather, it would appear from the disclosure of Renner that the data on the smart card is always read by the ICR and the programmed ICR then uses the read data in combination with other parameters, such as the time of day, number of previous access to the physical area, etc., to thereby control access to physical areas.

In sum, *nowhere* does Renner disclose, describe, teach, or suggest that it would be desirable to provide a system in which code data stored on a readable media is limited to being read a predetermined number of times, i.e., a system such as claimed having the

advantage of limiting use of the data stored on the smart card even when the smart card is inserted into other remote controls. Absent such disclosure, description, teaching, or suggestion, nothing from within Renner can be said to demonstrate that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have combined Pariente and Renner to arrive at the invention claimed. For at least this reason, it is respectfully submitted that the rejection of claims 1-10 must be withdrawn.

It is additionally submitted that a *prima facie* case of obviousness has not been presented for any of dependent claims 2-10. In this regard, the Office Action fails to set forth where either Pariente or Renner disclose the elements set forth in these claims, considering each and every word. For example, the Office Action never asserts that either Pariente or Renner discloses, teaches, or suggests code data stored on a readable media that is limited to being read by a remote control a predetermined number of times where the code data specifically: 1) functions to add codes to the remote control; 2) functions to allow remote control access to limited-access programming; 3) functions to allow timed access to limited-access programming; 4) functions to allow a predetermined number of accesses to limited-access programming; 5) functions to enable access to a code stored within the remote control; 6) functions to associate command codes within buttons of the remote control; or 7) functions as data representative of a channel line-up of a broadcast service provider. Since the burden of presenting a *prima facie* case of obviousness with respect to claims 2-10 has not been met, the rejection of claims 2-10 must be withdrawn.

Considering now the rejection of claims 11-17 based upon the combination of Pariente and Ishikawa, it is respectfully submitted that Ishikawa cannot be said to suggest modifying the system of Pariente to arrive at the invention claimed. In this regard, Ishikawa describes a system in which a remote control (10) is used to navigate a channel guide displayed on the cathode ray tube (18) of a television. Ishikawa does not, however, disclose,

describe, teach, or suggest that it would be desirable to store code data on a readable media where the stored code data comprises data representative of a channel line-up for a broadcast provider. Ishikawa also fails to disclose, describe, teach, or suggest that it would be desirable, in response to activation of a key of the remote control, to read code data *from the readable media* to cause the issuance of a command to tune an appliance to a specific channel in the channel line-up stored on that readable media. Absent any such disclosure, description, teaching, or suggestion, nothing from within Ishikawa can be said to demonstrate that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have combined Pariente and Ishikawa to arrive at the invention claimed. For at least this reason, it is respectfully submitted that the rejection of claims 11 and 14-17 must be withdrawn.

It is additionally submitted that a *prima facie* case of obviousness has not been presented for any of dependent claims 14-16. In this regard, the Office Action fails to set forth where either Pariente or Ishikawa disclose the elements set forth in these claims, considering each and every word. For example, the Office Action never asserts that either Pariente or Ishikawa discloses, teaches, or suggests code data stored on a readable media that comprises data representative of a channel line-up and further comprises: 1) access data for allowing the remote control to be used to access limited-access programming in that channel line-up; or 2) the access data being transmittable from the remote control a predetermined number of times. Since the burden of presenting a *prima facie* case of obviousness with respect to claims 14-16 has not been met, the rejection of claims 14-16 must be withdrawn.

Considering now the rejection of claims 18 and 19 based upon the combination of Pariente and Krisbergh, it is respectfully submitted that Krisbergh cannot be said to suggest modifying the system of Pariente to arrive at the invention claimed. In this regard, Krisbergh describes a system in which a converter/descrambler (40) is preauthorized with a certain

number of credits for receiving pay-per-view services. Krisbergh does not, however, disclose, describe, teach, or suggest that it would be desirable to store code data on a readable media where the stored code data comprises data representative of a credit amount, i.e., a system such as claimed having the advantage of allowing credit data stored on the smart card to be used to gain access to pay-per-view events even when accessed by means of plural, different converters/descramblers or other remote controls. As noted in the Office Action, Krisbergh discloses nothing more than the desirability of storing a credit amount on a single, preauthorized converter/descrambler. Thus, absent any disclosure, description, teaching, or suggestion that it would be desirable to stored data representative of a credit amount on a readable media readable by a remote control *to limit transmissions of signals* to a home appliance, nothing from within Krisbergh can be said to demonstrate that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have combined Pariente and Krisbergh to arrive at the invention claimed. For at least this reason, it is respectfully submitted that the rejection of claims 18 and 19 must be withdrawn.

Without acknowledging the correctness of the obviousness-type double-patenting rejection (believing that the restriction requirement during the prosecution of the application that resulted in U.S. Patent No. 6,657,679 contradicts the assertion that the subject claims and the claims of the '679 patent are obvious variants of each other), a terminal disclaimer is nevertheless being submitted herewith only for the purpose of expediting the prosecution of the subject application for patent.

## CONCLUSION

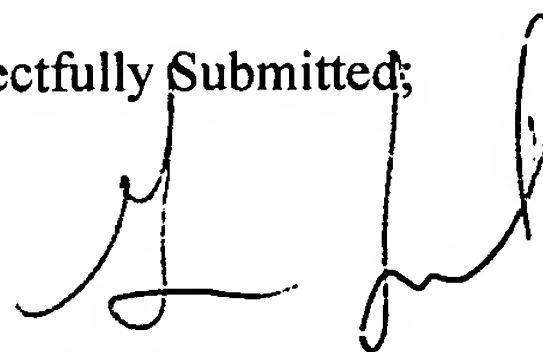
As discussed above, the rejections of the claims reflect the impermissible use of hindsight reasoning, namely, the finding of various terms in the references cited and the using of the applicants disclosure to somehow link those terms for the purpose of deprecating the

invention claimed. Accordingly, the rejections of the claims are improper and the subject application must be considered to be in condition for allowance.

Should it be determined that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

While it is not believed that any fees are due, the Commissioner authorized to charge any fee deficiency to deposit account number 50-2428.

Respectfully Submitted;

A handwritten signature in black ink, appearing to be 'G. Jarosik', written over a horizontal line.

Date: April 12, 2005

By: Gary R. Jarosik, Reg. No. 35,906  
Greenberg Traurig, LLP  
77 West Wacker Drive, Suite 2500  
Chicago, Illinois 60601  
(312) 456-8449